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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,009	03/16/2001	Jean-Marc Ascione	05725.0634-00	5103

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EXAMINER

ELHILO, EISA B

ART UNIT	PAPER NUMBER
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1751

13

DATE MAILED: 02/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/809,009

Applicant(s)

ASCIONE ET AL.

Examiner

Eisa B Elhilo

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 1751

DETAILED ACTION

- 1 This action is responsive to the supplemental request filed on January 16, 2003.
- 2 Upon further review and consideration the prosecution is reopened. *Ex parte* prosecution is resumed. Claim 1-65 are pending in this application.

NEW GROUND OF REJECTION

Claim Rejections - 35 USC § 112

- 3 The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 14 and 34 contain the trademark/trade names " Steareth-20" and "Beheneth-25". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe anionic copolymers and, accordingly, the identification/description is indefinite.

Art Unit: 1751

Double Patenting

4 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-65 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-76 of co-pending Application No. 09/809,007. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced co-pending application and would be covered by any patent granted on that co-pending application since the referenced co-pending application and the instant application are claiming common subject matter, as follows: The claims are drawn to similar methods for providing physical stability to the compositions and similar methods for treating keratinous fibers using similar compositions. The compositions comprise similar ingredients having similar properties different only in that the instant claims recite a composition comprising at least one oxidizing agent. However, the claims of the co-pending application No. 09/809,007 teaches and discloses dyeing compositions comprising oxidizing agents (see claims 17 and 70), methods comprising applying a composition that comprises oxidizing agents (see claims 34 and 53) and multi-compartment devices or kits comprising bleaching agents (oxidizing agents) (see claim 76).

Art Unit: 1751

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make such a composition because the claims of the co-pending application teach and disclose that oxidizing agents are used in the composition and, thus, a person of ordinary skill in the art would expect such a composition to have similar properties to those claimed, absent unexpected results.

Claim Rejections - 35 USC § 103

5 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 8-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over de la Mettrie et al. (US' 5,989,295) in view of (XP-000934522).

De la Mettrie (US' 295) teaches an aqueous hair dyeing composition comprising anionic amphiphilic polymers containing at least one hydrophilic unit of unsaturated olefinic carboxylic acid and at least one hydrophobic unit which is a C10-C30 alkyl ester of unsaturated carboxylic acid. The hydrophilic unit of unsaturated olefinic carboxylic acid corresponds to the monomer of the formula (I) in which R1 denotes H, CH3 or C2H5 that is to say acrylic acid, methacrylic acid or ethacrylic acid units and in which the hydrophobic unit of C10-C30 alkyl ester of unsaturated carboxylic acid corresponds to the formula (II) in which R1 denotes H, CH3 or C2H5 that is to say acrylate, methacrylate or ethacrylate units and R2 denotes a C10-C30 alkyl radical C10-C30 alkyl ester of unsaturated carboxylic acids such as lauryl acrylate, stearyl acrylate, decyl acrylate lauryl methacrylate or stearyl methacrylate (see col. 3, lines 50-67,

Art Unit: 1751

formula I and col. 4, lines 1-20 and formula II), oxidizing agents such as hydrogen peroxide solution in the amount of 2.5 to 40 volumes (see col. 9, lines 52-55). The anionic polymer in the amount range from 0.05 to 10% by weight relative to the total weight of the dye composition (see col. 5, line 5), other agents such as anionic, nonionic or amphoteric surfactants (see col. 9, lines 30-31). De la Mettrie also teaches a method for dyeing hair which comprises the steps of applying to hair a mixture of oxidation dye composition and oxidizing composition and leaving the mixture to act for an exposure time preferably from 1 to 60 minutes, in rinsing the fibers and then washing with shampoo, then rinsing then again and dyeing then (see col. 10, lines 15-24). de la Mettrie further, teaches a multi-compartment kit for treatment of keratinous fibers (see col. 3, lines 16-43).

The instant claims differ from the reference by reciting a composition comprising at least one additional anionic associative polymer comprising at least one carboxylic acid group and at least one ester derived from an alkoxyated fatty alcohol and a carboxylic acid such as Acrylate/Steareth-20 Methacrylate Copolymers or Acrylates/Beheneth-25 Methacrylate Copolymers. However, the primary reference teaches and suggests a composition comprising at least one anionic polymer, which implies that more than one polymer, can be used in the composition.

(XP'522) in analogous art of cosmetic formulation teaches that Acrylates/Methacrylates/ Beheneth-25 Methacrylate Copolymers are used in hair care products such as shampoo, conditioners, gel and hair dyeing (see page 1, 5th paragraph).

Therefore, in view of teaching of the secondary reference, one having ordinary skill in the art at the time the invention was made to be motivated to modify the primary reference by

Art Unit: 1751

incorporating the Acrylates/Methacrylates/ Beheneth-25 Methacrylate Copolymers as taught by (XP' 522) to make such a composition. Such modification would have been obvious because (XP' 522) clearly suggests the use of Acrylates/Methacrylates/ Beheneth-25 Methacrylate Copolymer in cosmetic formulation because it is a liquid and has advantage over other thickeners and stabilizers that require special handling, mixing and solubility parameters (see page 1, 4th paragraph), and, thus, a person of the ordinary skill in the art would be motivated to add this polymer in the composition with reasonable expectation of success.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over de la Mettrie et al. (US' 5,989,295) in view of (XP-000934522) and further in view of de la Mettrie et al. (US 5,976,195).

The disclosures of de la Mettrie (US' 295) and (XP-522) are summarized above. The references fail to teach compositions comprising anionic associative polymer, which is crosslinked with allyl ether as claimed. However, the references teach compositions comprising similar anionic polymers that used as thickeners in cosmetic compositions as disclosed above.

De la Mettrie (US' 195) teaches in analogous art a hair dyeing composition comprising anionic amphiphilic polymers containing at least one hydrophilic unit and at least one allyl ether unit containing a fatty chain which are selected from those in which the hydrophilic unit contains an ethylenic unsaturated anionic monomer, more particularly a vinyl carboxylic and most particularly an acrylic acid, a methacrylic acid or mixtures thereof, and whose allyl ether unit containing corresponds to the monomer of the formula (I) in which R denotes a hydrocarbon radical selected from alkyl, arylalkyl and cycloalkyl radicals which contain from 8 to 30 carbon

Art Unit: 1751

atoms (see col. 3, lines 22-64), other crosslinked terpolymers of methacrylic acid of ethyl acrylate of polyethylene glycol (10E0) ether of stearyl alcohol (see col. 3, lines 57-59).

Therefore, in view of the teaching of the secondary reference, one having ordinary skill in the art would have been motivated to modify the primary reference by using anionic associative polymer, which is crosslinked with allyl ether to make such a composition. Such modification would be obvious because one would expect that the use of such polymer as taught by de la Mettire (US' 195) would be similarly useful and applicable to the analogous composition taught by de la Mettire (US' 295).

Response to Applicant's Arguments

6 Applicant's arguments filed 1/16/2003 have been fully considered but they are rendered moot in view of new ground of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B Elhilo whose telephone number is (703) 305-0217. The examiner can normally be reached on M - F (7:30-5:00) with alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (703) 308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7718 for regular communications and (703) 746-7171 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Application/Control Number: 09/809,009

Page 8

Art Unit: 1751

Elhilo

February 8, 2003


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